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09/731,342	12/06/2000	Benjamin Wiegand	JBP-529	9185
7590	06/15/2005			
Philip S. Johnson, Esq. Johnson & Johnson One Johnson & Johnson Plaza New Brunswick, NJ 08933-7003			EXAMINER YU, GINA C	
			ART UNIT 1617	PAPER NUMBER

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,342

Applicant(s)

WIEGAND ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of amendment and remarks filed on March 2, 2005, and August 27, 2004, respectively. Claims 1-9, 11-16, and 18-20 are pending. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action dated March 25, 2004 are withdrawn in view of claim amendment. Claim rejection made under 35 U.S.C. § 102 (b) in view of Dawson et al. (US 4772427) as indicated in the same Office action is withdrawn in view of claim amendment and modified to address new claim limitations. Claim rejection made under 35 U.S.C. § 102 (b) in view of Herman (Global Cosmetic) is withdrawn in view of claim amendment. Claim rejection made under 35 U.S.C. § 103 (a) in view of Dawson and Santora et al. (US 6046145) is withdrawn in view of further consideration. Claim rejection made under 35 U.S.C. § 103 (a) in view of Herman and Damani et al. (US 4514385) is withdrawn in view of applicants' remarks. New rejections are made.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether claim 16 is active or to be cancelled, for claim 16 is listed twice under the markings "Original" and "Currently Canceled".

Claim 19 is rejected as it depends on a non-existing claim, claim 21.

***Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1. Claims 1, 4-8, 11-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dawson et al. (US 4772427) (“Dawson”) as evidenced by Merck Index (1976, 9<sup>th</sup> ed.).**

Dawson discloses a topical ringing gel composition comprising sodium lauryl ether sulfate (an anionic surfactant), polyoxyethylene-glycol ether of lanolin alcohol (a nonionic surfactant), isopropyl myristate, and perfume. See Example 1. See instant claim 1. The example formulations in Examples 2-12 contains isopropyl myristate, meeting the oil phase limitation of instant claims 1, 4-6. The method of depositing benefit ingredients, such as color as claimed is inherently practiced by applying the prior art composition. The formulations also discloses using water to make up 90% of the total weight. See instant claims 11-17. The reference further teaches in col. 8, lines 26 – 36 to add suitable additives which are compatible with the gel and do not adversely affect the gel structure, and recites coloring agents, preservatives, and antiseptic agents. The limitations “antimicrobial agents”, “antiseptics”, and “antiinfectives” in claims 1 and 20 are thus met.

Merck Index teaches that isopropyl myristate is a liquid of low viscosity. See p. 5069; instant claims 7 and 8. Merck also teaches that isopropyl myristate is used in

cosmetic and topical medicinal preparations where good absorption through the skin is desired. Thus it is viewed that "medicament agents" and "skin conditioner" limitations are met.

**2. Claims 1, 4-8, 11-16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Flick (Cosmetic and Toiletry Formulations, 2<sup>nd</sup> ed, Vol. 7).**

The method of using ringing gel for topical application has been known in cosmetic art, as evidenced by Flick. Flick discloses ringing gel formulation with moisturisation, which comprises 10 % of glycerine (humectant, skin emollient and moisturizer), and mineral oil. See p. 241, Ringing Gel. See also Micro Emulsion Ringing Gel which comprises light mineral oil and glycerine and shea butter as the benefit agents (hair moisturizers, hair conditioners, hair softeners). Each formulation uses 10 % of emulsifier (oleth-5) and 42.40 w/w/ and 53.70 w/w, respectively, of water. See instant claims 11-13. Furthermore, the clear ringing gel composition in p. 29 delivers 17 % mineral oil, which is a well known emollient; the waterless hand cleaner shown on p. 362 delivers an antiseptic agent, d-limonene. See instant claim 14.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**1. Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson as applied to claims 1, 4-8, 11-16 and 20 as above, and further in view of Santora et al. (US 6046145) and Rubin et al. (US 4375421).**

While Dawson teaches using 2-4 % of isopropyl myristate, the reference fails to teach using 5-40 % by weight of oil phase. The reference also teaches using up to 23 % alkyl ether sulfate surfactant and up to 24 % of ethoxylated fatty alcohol or fatty ester, but fails to meet the claimed 60-95 % weight limitation for the surfactant phase. See instant claim 9. Dawson fails to teach amphoteric surfactants.

Santora et al. teach a cleansing and moisturizing surfactant compositions comprising nonionic, amphoteric, and anionic surfactants in the amount of 5-20 % by weight and humectants in 0.01-3 % by weight, see col. 2, lines 14 – 32. Instant claims 10, 13-15 are met by this disclosure. The surfactants of claims 2 and 3 are disclosed in col. 3, line 22 – col. 5, line 12 and in col. 7, line 8 – col. 9, line 29. The surfactant system is said to provide mildness, non-greasiness, and non-irritating effects upon application to skin or hair, and provides good cleansing and moisturizing action. See col. 1, line 13 – col. 2, line 59. The mildness to eyes is especially emphasized. Addition of fragrance, coloring agents, and chelating agents is also disclosed, meeting claim 1. The method of depositing the benefit agents is practiced by topically applying the composition as taught.

Rubin teaches viscous compositions containing up to 25 % of amido betaines, up to 40 % of salts, and up to 4 % of micelle-forming anionic surfactants. The reference teaches that many of the invention compositions are ringing gel types. The reference also teaches a formulation which comprises amido betains, salts, and nonionic surfactants. The reference also teaches that ringing gel compositions comprising

amphoteric and anionic surfactants are well known in cosmetic and toiletry art. See col. 2, bridging par.

Generally, difference in concentration will not support patentability unless criticality of the concentration is shown. In this case, the references generally teach the ratio of oil and surfactants to make a ringing gel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have discovered the optimum amounts of oil and surfactants that form a ringing gel by routine experimentation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Dawson by adding the surfactants as suggested by Santora because of the expectation to have successfully produced a mild and non-greasy skin or hair care compositions with good cleansing effects. The skilled artisan would have had a reasonable expectation of successfully producing a ringing gel by adding amphoteric surfactants because Rubin teaches that it is well known to use amphoteric surfactants in combination with anionic or nonionic surfactants to make ringing gel compositions.

**Claims 1, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable Damani et al. (US 4514385) in view of Herman (Global Cosmetic, August 1999).**

Damani teaches that a gel acne treatment is well known in the art. Example 1 shows a gel composition using salicylic acid and benzoyl peroxide. The method of depositing the acne agents onto the skin is an obvious use of the composition.

Herman discloses that the basic components of a ringing gel formulation are oil, water, a surfactant, and a cosurfactant. See p. 22, 1<sup>st</sup> col., the paragraph bridging cols.1 and 2. See col. 2 penultimate paragraphs where the surfactants are mixtures that read on claims 1(a) and 20 (a). The oil phase reads on claims 1(b) and 20(b).

The reference teaches the general applicability the "ringing gel" for personal care compositions. See p. 22, 1<sup>st</sup> col.; 1<sup>st</sup> paragraph and p. 22, 1<sup>st</sup> col., 1<sup>st</sup>.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Damani by substituting the gel vehicle with the ringing gel composition of Flick as motivated by the reference because Damani teaches the composition in gel, and Herman teaches that ringing gel is used for upscale skin care applications. The skilled artisan would have had a reasonable expectation of successfully producing a similar acne treatment gel composition.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 11-16, and 18-20 have been considered but are moot in view of the new ground(s) of rejection in part and not persuasive in part.

Applicants assert that one of ordinary skill in the art would not have been motivated to modify the Dawson ringing gel composition. Applicants reason that an altered formulation would not produce the same post-foaming gel shower product that is desired by Dawson. The instant claims are not even defined by specific amounts of each type of surfactant. Examiner asserts that the motivation to make the claimed invention in this case lies on the premises that a skilled artisan would have been



motivated to make an improvement over a prior art in view of the teachings that were available to him at the time of the present invention. In this case, Rubin teaches that ringing gel can be made by using mixtures of different types of surfactants. Santora teaches the specific benefits of using the claimed surfactants in topical formulations, i.e., reduced irritation. In view of the combined teachings of the prior arts, examiner takes the position that the claimed method of using a ringing gel composition comprising anionic, nonionic, and amphoteric surfactants would have been obvious to the skilled artisan at the time the present invention was made.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

**SHENGJUNWANG**  
**PRIMARY EXAMINER**